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OFFICE OF PETITIONS

In re Application of
Mo-Han Fong et al.
Application No. 10/673,480
Filed: September 30, 2003
Attorney Docket No. 0583P57US01

ON PETITION

This is in response to the Petition To The Director Under 37 CFR 1.182, filed June 24, 2010, which is being treated as a petition under 37 CFR 1.59 to expunge information from the above identified application.

The petition requests expungement of the examiner's prior art search strategy, the examiner's search notes, the Notice of References Cited and pages 2-5 of the Notice of Allowability all dated March 24, 2010.

The petition under 37 CFR 1.59 is dismissed.

The instant petition indicates that petitioner has or may suffer irreparable damage or prejudice due to the existence of the examiner's alleged improper search and reasons for allowance in the above noted papers.

37 CFR 1.59 provides for the applicant's request for expungement of information in a patent application, other than the original papers upon which the filing date was granted. However, under the terms of the rule, petitioner "must ...establish to the satisfaction of the Director that the expungement of the information is appropriate..." See 37 CFR 1.59(b). Under the circumstances of this case, petitioner has not met his burden of proof.

The requested expungement of the contested Office communication would have the effect of vacating that action. However, the USPTO has long declined to vacate an Office action except in an instance where the examiner clearly lacked jurisdiction of the case at the time that the contested Office communication was issued. See *Ex Parte Brunner*, 1872 Dec. Comm'r Pat. 62,

63 (Comm'r Pat. 1872) (Commissioner vacating examiner's Office action which reopened prosecution as the examiner then lacked jurisdiction of the case). Merely because an applicant contends that a given action contains an improper rejection or requirement per se is not an adequate reason for deleting that action in its entirety from the administrative record, which the USPTO has long striven to maintain as complete and accurate as possible.

Indeed, expungement of an Office communication would only be justified where that Office communication contained inappropriate statements that were not suitable for retention in the administrative record. Cf. 37 CFR 1.3, which requires that applicants must conduct their business with the USPTO with decorum and courtesy. Even where expungement is warranted for an Office communication, a redacted version is maintained in the file; only the offensive language is removed.

While petitioner may disagree with some of the contents of the contested Office communication, the USPTO has also long held that a mere difference in opinion does not warrant expungement of part or all of a contested communication from the file record. See e.g., *Ex Parte Fox*, 1910 Dec. Commissioner Pat. 123 (Comm'r Pat. 1910). The MPEP makes clear that the expungement of record information should occur in very limited situations. See MPEP § 724.05. That particular section of the MPEP and referenced-sections (e.g., MPEP § 724.02) address the following types of information as subject (or susceptible) to possible expungement:

- 1) trade secret information;
- 2) proprietary information;
- 3) protective order material;
- 4) unintentionally-submitted information; and
- 5) information submitted in a wrong application.

The above situations are the only known types of circumstances which have led to information expungement. Clearly none of the above apply here. Petitioner has not alleged that the contested Office communication includes any trade secret, is proprietary in nature, is subject to a protective order, or contains language that is inconsistent with the USPTO's own requirement for courtesy and decorum in the written record. It is also evident that the information was not wrongly submitted, and the examiner had jurisdiction of the case at the time the contested communication was issued.

Accordingly, no adequate basis is given or apparent for expunging the contested Office communication, and the USPTO sees no reason to exercise its discretion to deviate from, or expand upon, the above long-established reasons for expungement. See, e.g., *Saxbe v. Bustos*, 419 U.S. 65, 74 (1974) (acknowledging an agency's right to maintain a "longstanding administrative construction"). This is particularly so in this instance since as recognized by petitioner, consideration of issues pertaining to the merits of a given rejection will not be entertained on petition. See 37 CFR 1.181(a); see also *Boundy v. U.S. Patent & Trademark*

Office, 73 USPQ2d 1468 (DC Eva 2004), appeal dismissed, 2004 U.S. App. LEXIS 26384 (Fed. Cir. 2004).

DECISION

For the reasons given above, the petition under 37 CFR 1.59 to expunge the papers of March 24, 2010, is dismissed.

In the alternative, petitioner requests this petition be entered into the file wrapper as Comments on the Reasons for Allowance.

The application is being forwarded to the Office of Data Management. This petition will be treated as Comments on the Reasons for Allowance as set forth in MPEP 1302.14(V).

Petitioner filed this petition with a petition fee of \$400, however a petition under 37 CFR 1.59 requires a fee of on \$200. The excess fee of \$200 has been refunded to petitioner's deposit account.

Telephone inquiries relative to this decision should be directed to Carl Friedman at (571) 272-6842.



Carl Friedman
Petitions Examiner
Office of Petitions